

REMARKS

Applicant submits this Response and RCE paper in response to an office action and final rejection mailed on August 16, 2005 for the above-referenced application. Applicant respectfully requests a two-month extension of time and submits concurrently herewith a form request and the required fee. Applicant respectfully requests reconsideration and allowance of the pending claims 21-38 and 52-60. New claims 67 through 80 have been added. This new set of claims includes the further limitation that a bar code scanner at the remote computer is used to identify the pre-recorded video product to be previewed. The remote computer transmits the identification of the pre-recorded video product to be previewed to the central host server. This limitation is supported, e.g., by language found at Col. 14, line 62 through Col. 15, Line 3. The new claims are substantially identical to the pending claims except for the addition of this limitation concerning the bar-code scanner. The correspondence between the new claims and the pending claims is as follows:

- Claim 67 is similar to claim 21.
- Claim 68 is similar to claim 22.
- Claim 69 is similar to claim 23.
- Claim 70 is similar to claim 24.
- Claim 71 is similar to claim 25.
- Claim 72 is similar to claim 26.
- Claim 73 is similar to claim 27.
- Claim 74 is similar to claim 28.
- Claim 75 is similar to claim 29.
- Claim 76 is similar to claim 30.
- Claim 77 is similar to claim 31.
- Claim 78 is similar to claim 32.
- Claim 79 is similar to claim 33.
- Claim 80 is similar to claim 34.

Section 112, First Paragraph Enablement Rejections

The Examiner has rejected claims 21-38 and 52-60 (the pending claims) on the basis of enablement. The first ground relates to the provision of video over the internet. Applicant respectfully traverses the rejection as stated at page 3, lines 1-17. The pending claims including the limitation of a central host server are intended to cover two embodiments of the present invention. The first embodiment is an in-store kiosk that accesses a central host server over the internet. (Starting at Col. 9.) The second embodiment is the implementation of the preview services on an internet based central host server accessible by remote computers without regard to whether that remote computer is located in a retail location or not. (Starting at Col. 15.) These two internet embodiments are to be distinguished from the stand-alone kiosk embodiment described starting at Column 5, line 63. It is specifically described in the language quoted from column 18, lines 10-62 that the video product embodiment is intended to be applied to the in-store kiosk that accesses a central host server over the internet and the kiosk-independent remote computer accessing the central host server. The reference to kiosk in the quoted passage is not a reference to the original kiosk embodiment described starting at Col. 5, line 63. Thus, it is specifically contemplated for the pending claims that the source of the previews of video products is the central host server accessible from the remote computers via the internet. Applicant submits that the disclosure at Col. 18, lines 10-62, and the remaining parts of the instant specification devoted to file management and file access, the coupled with the knowledge of the person having ordinary skill in the art in 1995, are sufficient to enable the currently pending claims.

The Examiner also rejects the claims on the grounds that the specification does not mention “web browser” or “web browser process.” Applicant respectfully traverses this rejection. The concept of web browsing and the need to have web browsing capability to access a network web site acting as the central host server is disclosed in Figures 35-36, 38-42, 46-50, and 52-57. It is also described at Col. 4, lines 51-52; Col. 5, lines 4-7; Col. 9, lines 12-35; Col. 15, lines 12-28 and 35-37.

The Examiner also rejects the claims on the grounds that CD-ROM is only described for the local kiosk. Applicant respectfully traverses. The specification, in discussing the two internet-based embodiments, discusses the requirement for mass data storage at the central location (Col. 9, lines 16-18) while specifically describing the use of a RAID array in the

preferred embodiment (Col. 9, line 64.) The specification discusses the equivalents of CD-ROMs and RAID arrays at Col. 4, lines 48-50. These disclosures, combined with the disclosure of CD-ROMs used as the mass storage for the central host server in the original application (see claim 5 at page 28, lines 1-2 of the parent application, Application Serial No. 08/741,915), satisfy the requirements of Section 112.

Section 103 rejection of claims 21, 23, 24, 26-29, 34, 38, 53, 56, and 59

Claims 21, 23, 24, 26-29, 34, 38, 53, 56, and 59 have been rejected under 35 U.S.C. § 103 as unpatentable over Tsevdos et al. (USPN 5,734,719)(hereinafter "Tsevdos"), and further in view of an article describing a service called eShop ("eShop Brings Dynamic Retailing to the Internet," Business Wire, 7/13/1995). Applicant herein incorporates the arguments made in response to this rejection as found in the previous amendment.

In response to these previous arguments, in the Final Rejection, the Examiner agrees that Tsevdos does not teach the use of a web site, a web browser process or web server. The Examiner submits that Tsevdos "would be motivated" to implement its system using web browser technology "for the obvious reason of increasing usage and thus revenue of its system." (See August 16, 2005 Office Action at pages 14-15.) Applicant respectfully disagrees.

At the time of the present invention in 1995 and 1996, there was no motivation to move Tsevdos to an internet-based service. Rather than view the technological possibilities in a vacuum, it is essential to view the business environment in which the technology is designed to operate. In this case, Tsevdos was designed as part of a business venture between IBM and Blockbuster called New Leaf Entertainment. The business of New Leaf was to provide in-store CD-manufacturing capabilities using a closed network to allow consumers to make customized CDs containing only tracks of their choosing. As was described in the press,

Last year's technological buzz at MIDEM was the much-heralded New Leaf Entertainment, a joint venture of IBM Corp. and the video chain Blockbuster Entertainment Corp., that would enable customers to mix and match their own recording artists – creating a CD of Frank Sinatra recordings, for example, along with those of George Michael and Alice in Chains. (See Exhibit A hereto.)

However, the copyright holders (music artists) were concerned about making copyrighted music content available to New Leaf because they feared that they would lose the ability to control content distribution and to collect the appropriate royalty. Additionally, the artists feared

that providing the consumer with the ability to cherry-pick tracks from a CD would doom sales of the artists' CDs in due course. These fears and concerns led the music industry to resist New Leaf's technological advances and to refuse to make copyrighted content available for distribution on New Leaf's in-store kiosks.

These fears and concerns were leveled at New Leaf's private network as described in Tsevdos. In light of these fears and concerns about distribution of copyrighted content over a private network, applicant submits that there was no motivation to move Tsevdos to an open network such as the internet. Given the copyrighted content security issues expressed by the major music labels, those of ordinary skill in the art would not have been motivated to move Tsevdos' private network to the public internet. In fact, the business environment at the time seemed to have called for increased security via a private network.

Applicant submits that since there was no motivation to move the Tsevdos private network to the public internet, the combination of Tsevdos with internet-based prior art such as the eShop article or the ISN article is improper. There would be no motivation to combine the Tsevdos private network with the eShop and ISN public network based applications.

Conclusion

In view of the remarks provided herein, it is respectfully submitted that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration and allowance of these claims. If there are any additional charges, please charge them to our Deposit Account Number 04-0822.

Respectfully submitted,
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Dated: January 17, 2006

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Enclosures.

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